the staple is driven, the staple could not fully be driven home. If the driver extended beyond the end of the slide at the conclusion of the driving stroke the upholstery material which is being stapled would be torn or gouged. Further, it has been shown that a rigid connection between the piston and the driver makes for excessive driver breakage. But where the driver is divorced from the piston, and where separate stops are provided both for the piston and the driver, so located that after the piston has been arrested the driver can move forwardly under its own momentum, the full power of the driving stroke ceases when the piston is arrested, and the driver is able to continue its motion under the lesser force of its own inertia so that it can drive the staple home without tearing or gouging the upholstery fabric.

As a result of the invention staples are now being widely used in industry. These stapling tools are available to the industry from Petitioner, Senco Products, Inc., from Respondents, Fastener Corporation and Duo-Fast Co., and from Bostitch, Inc. Those made by Senco and Bostitch are made under authority of the patent. The respondents admittedly use the patented free running driver feature in their staples but seek to avoid recognizing the patent in suit.

The Prior Art.

The Court of Appeals relied on five items of prior art in holding the patent invalid. As to each the Court made the following statements:

Bradeen patent No. 451,995 (*A. pp. 722-728*)

"The Bradeen tacking machine patent incorporates the basic essentials of stapling machine devices. The driver and piston form one piece and there is but one stop for the piston and driver." (App. A. p. 19.)

Randall patent No. 1,939,632 (A. pp. 832-841)

"This device utilized a piston separate from the driver, although the latter was rigidly secured to a floating auxiliary plunger. There were, however, no separate stops for the piston and driver." (App. A. pp. 18-19.)

Randall "Commercial" gun (Shown in Defendants' Exhibit 226)

"In a Randall commercial gun introduced in evidence by Defendants and represented by drawings in defendants' exhibit 226 there was a loose connection between the piston and driver which allowed the driver a slight degree of movement after the piston had stopped." (App. A. p. 19.)

Von Vass patent No. 1,186,458 (A. pp. 801-805)

"The Von Vass patent 1,186,458 covering a nailing device employed a piston which was separate from the driver. The piston was stopped independently of the driver. A spring served as a stop for the driver." (App. A. p. 19.)

Carmina patent No. 1,142,671 (A. pp. 792-800)

"The Carmina patent 1,142,671 disclosed a construction in which a recessed piston is arranged to receive and drive a separate driver, provisions being made for separate stops for the piston and driver." (App. A. p. 19.)

ARGUMENT.

CONFLICT OF DECISIONS.

Staplers embodying the invention are widely used in many industries throughout the United States.

It is well settled that the Supreme Court should resolve conflicting views of two Courts of Appeals as to a single patent:

Expanded Metal Co. v. *Bradford*, 214 U. S. 366, 374.

Diamond Rubber Co. v. *Consolidated Tire Co.*, 220 U. S. 428, 430.

Sanitary Refrigerator Co. v. *Winters*, 280 U. S. 30, 34.

Triplett v. *Lowell*, 297 U. S. 638, 644.

Universal Oil Prod. Co. v. *Globe Oil & Ref. Co.*, 322 U. S. 471, 473.

In the case last cited the Supreme Court stated:

> "But in resolving conflicting views of two Circuit Courts of Appeals as to a single patent, we are obliged to undertake an independent re-examination of the factual questions."

The District Court in the sixth circuit found the patent in suit valid (A. p. 501). At oral argument before the Court of Appeals for the Sixth Circuit, counsel for the party opposed to the patent conceded validity, whereafter the Court of Appeals affirmed, *Sasser, et al.* v. *Seneca*, 242 F. 2d 565 (App. B. p. 23).

When a district court finds a patent valid, and patent validity is thereafter admitted upon appeal to the Court of Appeals, which Court of Appeals affirms, the validity

of the patent in that circuit is finally determined, *Sanitary Refrigerator Co. v. Winters*, 280 U. S. 30, 33.

In the case at bar the District Court in the seventh circuit found the patent in suit invalid (A. p. 671). The Court of Appeals for the Seventh Circuit affirmed, *Senco v. Fastener et al.*, 269 F. 2d 33 (App. A. p. 20).

This conflict must be resolved. The industry is completely up in the air as to whether the patent is valid or invalid.

STANDARD OF INVENTION.

The Patent Act of July 19, 1952, effective January 1, 1953, provides in part as follows (35 U. S. C. 103):

> "Patentability shall not be negatived by the manner in which the invention was made."

It does not appear that this Court has yet had occasion to apply this section of the new Patent Law. The "Reviser's Note" states that:

> "The second sentence states that patentability as to this requirement is not to be negatived by the manner in which the invention was made, that is, it is immaterial whether it resulted from long toil and experimentation or from a flash of genius."

The District Court in the seventh circuit held the patent in suit invalid because:

> "No where in the operation can I find the flash of creative genius which is necessary to constitute invention. *Cuno Engineering Corporation v. Automatic Devices Corporation*, 314 U. S. 84." (A. pp. 677, 678.)

Thus the District Court applied a standard of invention which Congress had specifically abrogated after some eleven years! The Court of Appeals for the Seventh Circuit affirmed this decision without comment on the standard of invention employed by the District Court. This confusion should be resolved.

PRESUMPTION OF VALIDITY—CASES AND STATUTE.

The Patent Act of July 19, 1952, effective January 1, 1953 provides as follows (35 U. S. C. 282):

> "A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it."

The *only* mention made by the Court of Appeals as to the presumption of validity is as follows (App. A. p. 20):

> "The presumption of validity arising from the grant of a patent does not exist as against prior art not before the Patent Office."

The statute (35 U. S. C. 282) makes no such exception!

Such holding is even in conflict with other decisions of the Court of Appeals for the Seventh Circuit which hold that the mere fact that a patent was not *cited* by the Patent Office does not mean that such patent was not "before" the Patent Office; it may have been considered and cast aside as not pertinent. *Adler Sign Letter Co.* v. *Wagner Sign Service*, 7 Cir., 112 F. 2d 264, 267.

Furthermore, the patent in suit did not issue until after the Patent Office had conducted a hotly contested three party interference in which patentability was the primary issue; the Patent Office found the claims patentable (A. pp. 511, 516). This Court has held that under similar circumstances this presumption of validity "must have greatly increased weight", *Hildreth* v. *Mastoras*, 257 U. S. 27, 32.

It is submitted, therefore, that the Court of Appeals for the Seventh Circuit did not properly apply the *statutory* presumption of validity to the patent at bar and that, if it had, it surely would have found the patent valid, especially in view of the fact that both the District Court and the Court of Appeals found the patent was for an improvement (A. p. 677 and App. A. p. 19)!

COMMERCIAL SUCCESS.

The stapler of the patent in suit met with surprising commercial success (A. p. 121). The Respondents praise the prior art but they follow the patent in suit, not the prior art, and they admit infringement (A. p. 7).

Long ago this Court recognized that commercial success, in a close case, could "turn the scale in favor of the invention", *Potts* v. *Creager*, 155 U. S. 597, 609, and "tip the scales in favor of patentability", *Goodyear Tire & Rubber Co.* v. *Ray-O-Vac Co.*, 321 U. S. 275, 279.

Finally, it has been observed that the Respondents praise the prior art but practice the invention. This is itself believed indicative of invention and has been so held by this Court, *Diamond Rubber Co.* v. *Consol. Tire Co.*, 220 U. S. 428, 441. Yet the Court of Appeals for the Seventh Circuit refused to consider commercial success on the ground it was irrelevant (App. A. p. 20).

This Court is respectfully urged by Petitioner to consider the factors which should tip the scales in favor of the patentability of the invention at bar.

MIS-STATEMENTS BY THE COURT OF APPEALS.

The Court of Appeals for the Seventh Circuit recognized that the patent at bar is for an "improvement and development" (App. A. p. 19). Since no court is warranted in deciding, *in vacuo*, whether an improvement is a *patentable* one, it appears that the Court of Appeals must have felt that the improvement was not patentable because the inventor simply borrowed certain features from the prior art and added them to existing structures.

The discussion of the prior art by the Court of Appeals (which essentially follows the analysis of the District Court) does not substantiate either that plaintiff

made his admitted "improvement and development" by borrowing from the prior art, or that plaintiff secured no "unusual or surprising consequences" from what he did.

In the preceding Statement of the Case *all* that the Court of Appeals had to say about the prior art it relied on is set forth verbatim. As to the Bradeen and Randall patents the Court of Appeals was substantially correct. As to the remaining three items of prior art it was not. **The incorrect interpretation of these three items is crucial.**

The Court referred to the Bradeen patent as showing an early effort at driving staples with an air operated tool. This patent, however, shows nothing more than an air operated driver with an air return: the driver is rigidly fixed to a piston and there are no separate stops for the driver and piston. The Randall patent shows a driver with a piston attached and a supplementary piston above it; but fails to show or suggest separate stop means for the driver assembly and for the supplementary piston. The Randall "commercial" gun simply shows the combination of a piston and a driver wherein the connection between the driver and the piston is characterized by a few thousandths of an inch of play, which could serve no purpose beyond that of facilitating the connection of the driver and piston during assembly of the structure. Indeed, there are no mechanical stops at all in this gun. *Thus, in the Randall commercial gun, the Randall patent and the Bradeen patent, there are no separate stops for the piston and the driver.*

This leaves only the Von Vass patent and the Carmina patent in the Court's opinion as sources from which plaintiff could have borrowed those features which constitute the improvement and development over the broad idea of an air actuated driver for staples as shown in Bradeen. *Neither patent is capable of serving as such a source.*

Von Vass (Appendix, p. 802) shows a hand operated, non-pneumatic device having a tubular body. A driver with a head extends through the lower end of the tubular body. A rod having a head extends through the upper end of the tubular body and is fitted with a handle. The driver is returned to an inactive position by a spring. In the use of the device, the rod is drawn upwardly by the operator (a plug 21 in the upper end of the tubular body coacts with the head 24 on the rod to prevent its complete withdrawal and this is the *only* function attributed to the member 21 by the patentee, A. p. 804, ll. 61-63) whereupon the rod is manually brought forcibly downwardly in the tubular body until its head 24 strikes the head 25 on the driver. The driver is, of course, moved forcibly downwardly as by a hammer blow; but the heads 24 and 25 remain together throughout the entire extent of the driver travel. While the driver may be stopped by the spring, the head on the rod cannot previously be stopped. A measurement of the figures of the Von Vass patent indicates that the two heads remain in contact throughout the entire extent of driver travel.

The Carmina patent (A. p. 792) is on a pneumatic percussion tool. It has a piston and it has also a chisel-receiving socket provided with a laterally extending spring pin. The chisel is provided either with an annularly reduced portion or with an elongated groove in which the pin may engage (Appendix, p. 796, Figs. 13 and 14). This is merely for the purpose of retaining the chisel in the socket. The structure of Carmina is employed by bringing the chisel against the work; and the chisel is caused to exert a blow on the work because it is hit by the air driven piston. But in the use of a structure of this kind where the cutting end of the chisel must be held against the work to be effective, the blow exerted on the chisel by the plunger can cause a movement of the chisel only to the extent that

the work is cut by the chisel. In the Carmina structure, the pin which has been described is not a separate stop for the chisel and could not act as such. If the device were held so that the chisel could move longitudinally, it is evident that the pin would be sheared off so that it could no longer even retain the chisel, let alone act as any kind of stop.

Plaintiff's concept which contemplates a piston, a driver which is free of the piston and separate means to stop both the driver and the piston, so that the driver is free to advance by inertia after the piston is stopped, is clearly not to be found in any prior art to which the Court has referred nor in any combination thereof. There simply was nothing in the prior art from which Plaintiff could have borrowed to arrive at the structure of the patent in suit.

It is submitted that the Court of Appeals was clearly in error in its analysis and application of the prior art. Correctly analyzed and applied, patentable invention would be clear! As herein previously noted, in cases wherein there is a conflict of decisions among the Courts of Appeal, and error has been made, it is the duty of the Supreme Court to re-examine and to resolve the conflict, *Universal Oil Prod. Co. v. Globe Oil & Ref. Co.*, 322 U. S. 471, 473 wherein it was stated:

> "But in resolving conflicting views of two Circuit Courts of Appeals as to a single patent, we are obliged to undertake an independent re-examination of the factual questions."

CONCLUSION.

Issuance of the writ of certiorari is respectfully prayed, for all of the above reasons, that upon review of this case the conflict of decisions between the Courts of Appeals for the Sixth and Seventh Circuits as to the validity of the patent at bar will be resolved; the correct standard of invention will be applied; the statutory presumption of validity will be followed; the mis-statements of the Court of Appeals for the Seventh Circuit will be corrected; and patent 2,671,214, admittedly infringed, will be held valid.

Respectfully submitted,

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APPENDIX A.

IN THE UNITED STATES COURT OF APPEALS
For the Seventh Circuit.

September Term, 1958—April Session, 1959.

No. 12548
SENCO PRODUCTS, INC.,
Plaintiff-Appellant,
v.
FASTENER CORPORATION and DUO-FAST CO.,
Defendants-Appellees.

Appeal from the United States District Court for the Northern District of Illinois, Eastern Division.

July 8, 1959.

Before SCHNACKENBERG, KNOCH and CASTLE, *Circuit Judges.*

CASTLE, *Circuit Judge.* Senco Products, Inc., plaintiff-appellant, a manufacturer of staples and staplers, (hereinafter called plaintiff) brought suit in the District Court against Fastener Corporation, a manufacturer of similar devices and Duo-Fast Co., its Illinois distributor, defendants-appellees, (referred to as defendants) for an injunction for damages for alleged patent infringement. The District Court entered judgment finding the patent invalid for lack of invention and dismissed the complaint. Plaintiff appealed. The main contested issue is whether the District Court erred in holding the patent invalid for lack of invention in view of certain prior art.

The stapling devices or "guns" manufactured by both parties are of a portable pneumatic type designed primarily for use in upholstering operations. The staple driving mechanism of the patent in suit features a separate driver and piston with a separate stop for the piston, so arranged that the driver and piston accelerate together and move as a unit in the staple driving operation until the piston is stopped. The driver, due to its accumulated kinetic energy, continues its movement to complete the setting of the staples without further force or energy from the piston. The driver advances slightly beyond the tip of the gun. A spring serves as a final limit stop for the driver. Advantages claimed for this mechanical arrangement are the elimination of frequent driver breakage encountered when the driver and piston are in one unit or when rigidly connected and proper staple setting without injury to the material stapled. Plaintiff contends that the two features—the separate driver and piston and the separate piston stop served to distinguish its patent from all prior art.

The defendants rely on references to prior art which they contend disclose the use of separate pistons and drivers and separate stops for each in similar tools. The references included devices for stapling, tacking, nailing, riveting and other percussion tools. It would unduly lengthen this opinion to discuss each reference in detail. We have considered each reference and the arguments of counsel bearing on its relevance.

Pneumatic stapling guns were actually designed as early as 1891 (Bradeen patent 451,995). Evidence of prior art considered by the District Court and upon which it based its conclusion included the Randall patent 1,939,632 covering a portable pneumatic stapling machine. This device utilized a piston separate from the driver, although the

latter was rigidly secured to a floating auxiliary plunger. There were, however, no separate stops for the piston and driver. In a Randall commercial gun introduced in evidence by defendants and represented by drawings of defendant's exhibit 226 there was a loose connection between the piston and driver which allowed the driver a slight degree of movement after the piston had stopped. The Bradeen tacking machine patent incorporates the basic essentials of stapling machine devices. The driver and piston form one piece and there is but one stop for the piston and driver. Other percussion tools, however, were shown to have incorporated separate pistons and drivers. The Von Vass patent 1,186,458 covering a nailing device employed a piston which was separate from the driver. The piston was stopped independently of the driver. A spring served as a stop for the driver. The Carmina patent 1,142,671 disclosed a construction in which a recessed piston is arranged to receive and drive a separate driver, provisions being made for separate stops for the piston and driver. The foregoing examples of prior art and evidence concerning tools in commercial use in our view sustain the District Court's conclusion that although the plaintiff's stapling device represented improvement and development, such improvement and development was the result of mechanical skill only. The arrangement of the features incorporated by the plaintiff in its device did not possess the "impalpable something which distinguishes invention from simple mechanical skill." *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U. S. 147. These features had been employed in other similar types of tools. Their adaptation by plaintiff resulted in an improvement but represents no more ingenuity than the work of a mechanic skilled in the art. There are no "unusual or surprising consequences from the unification of the elements here concerned" nor did plaintiff's utilization

of the features it mentions "add to the sum of useful knowledge". *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147.

It is enough to defeat a patent under 35 U.S.C.A. § 103 that from one or more related prior art patents, one having ordinary skill in the art would find the claimed invention obvious. *Enterprise Ry. Equip. Co. v. Keystone Ry. Equip. Co.*, No. 12508, C.C.A. 7th Cir., opinion filed May 20, 1959.

The presumption of validity arising from the grant of a patent does not exist as against prior art not before the Patent Office. *Hobbs v. Wisconsin Power & Light Company*, 250 F. 2d 100, 105. Of the aforesaid prior art relied upon by the defendants only Randall and Pardee patent 2,304,650 were before the Patent Office.

We hold the patent invalid for lack of invention. Consideration of commercial success is therefore irrelevant. *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147.

The judgment of the District Court is

AFFIRMED.

APPENDIX B.

IN THE UNITED STATES COURT OF APPEALS.
For the Sixth Circuit.

No. 12901
TRAVIS M. SASSER (doing business as Cincinnati Shippers Supply Co. and Dayton Fastener—both individual proprietorships owned by Travis M. Sasser) and Shipping Room Supplies, Inc.,
Defendants-Appellants,
v.
SENCO PRODUCTS, INC.,
Plaintiff-Appellee.

Appeal from the United States District Court for the Southern District of Ohio, Western Division.

Decided March 26, 1957

Before SIMONS, *Chief Judge*, and MCALLISTER and MILLER, *Circuit Judges*.

Per Curiam.

Senco Products, Inc., appellee, sued appellants for direct infringement of its patents for staplers; for contributory infringement; for inducing infringement thereof; and for unfair competition. Appellants defended on the ground that the patents in issue were invalid; that they had only sold repair parts of the patented devices; that appellee had been guilty of misuse of its patents by its intentional delay in supplying repair parts to users of appellee's device; and that there was no properly admissible evidence to sus-

tain appellee's claim that appellants had been guilty of unfair competition.

The district court found that appellants were guilty of infringement, contributory infringement and unfair competition; and that appellee had not misused its patents as alleged.

On the argument of the case on appeal, in reply to interrogation by the court, it was conceded by appellants that the patents in suit were valid, so that issue may, at the outset, be eliminated from consideration.

[1] With the issue of validity of the patents removed from the case, appellants' contention that they were not guilty of contributory infringement appeared to be its strongest defense, but that defense fails in view of the finding of the district court, which was supported by evidence, that appellants had sold components of appellee's patented staplers; and under the new Patent Code of 1952, Title 35 U.S.C.A. § 1 *et seq.*, it is provided in Section 271(c):

> "Whoever sells a component of a patented machine, manufacture, combination or composition, or a material or apparatus for use in practicing a patented process, constituting a material part of the invention, knowing the same to be especially made or especially adapted for use in an infringement of such patent, and not a staple article or commodity of commerce suitable for substantial noninfringing use, shall be liable as a contributory infringer."

[2] It further appears that appellants sold magazine assemblies comprising all the elements existing in one of the claims of appellee's patents, which constitute infringement thereof under Title 35 U.S.C.A. § 271(a).

[3] The proofs further disclose that appellants had hired away from appellee an important employee who held the position of assistant to appellee's office manager.

in order to secure secret trade information consisting of a list of appellee's best accounts, and the prices charged to its customers, resulting in undercutting of prices by appellants and the loss of many customers and great damage to appellee. The evidence also shows that appellants used appellee's arbitrary name and number designations for parts and staples, which they affixed to parts and staples which were not manufactured by appellee, but which appellants sold to the customers of appellee without any other indication of their origin. The foregoing conduct, repeated on numerous occasions by appellants, amply supported the district court's findings that appellants were guilty of unfair competition. See *Goodyear Tire & Rubber Co.* v. *Marbon Corp.*, D. C., 30 F. Supp. 420; *Ford Motor Co.* v. *Alltite Motor Products Corp.*, D. C., 117 F. Supp. 460 and 117 F. Supp. 584; *Keller, Inc.* v. *Chicago Pneumatic Tool Co.*, 7 Cir., 298 F. 52.

[4] Appellants claim that the district court erred in its finding that one of appellee's patents was valid, after counsel for appellee had offered to withdraw it on the hearing. It appears that at the time the offer of withdrawal was made, appellee had failed to supply proof of infringement; but, thereafter, evidence which was introduced by appellants justified the court in retaining the patent in question for consideration on the question of validity of infringement; and, accordingly, no reversible error appears in this regard.

The findings of the district court are sustained by the evidence; and no error appearing in its conclusions of law, the judgment of the district court is affirmed.